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By: Kris L. McNeill

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Paul Charles Turgeon

Application No.: 09/394,143

Filed: September 10, 1999

For: SYSTEM AND METHOD FOR
PROVIDING SECURE SERVICES
OVER PUBLIC AND PRIVATE
NETWORKS USING A REMOVABLE,
PORTABLE COMPUTER-READABLE
STORAGE MEDIUM AT A NETWORK
ACCESS DEVICE

Examiner: Calvin L. Hewitt II

Technology Center/Art Unit: 3621

APPELLANT REPLY BRIEF UNDER 37
CFR §1.193

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Sir:

Appellant offers this Reply Brief in response to the Examiner's Answer mailed on March 12, 2004. This Brief is submitted in triplicate. The following remarks are intended to further focus the issues in this appeal.

1. Related Appeals and Interferences

The Examiner's Answer appears to suggest that the statement in Appellant's Brief regarding related appeals and interferences was deficient (Examiner's Answer, pp. 1 – 2). Appellant notes that the following statement was provided in Appellant's Brief, and is believed to meet all requirements of the statement identified in 37 C.F.R. §1.192(c)(2):

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.
(Appellant Brief, p. 2).

2. Argument

The Grounds of Rejection provided in the Examiner's Answer appears to be a copy of the Final Office Action mailed September 24, 2003 (Examiner's Answer, pp. 3 – 8), and is supplemented by comments directed specifically at Appellant's Brief in the Response to Argument (*id.*, pp. 8 – 14). The arguments provided in the "Response to Argument" provided on pp. 8 – 14 of the Examiner's Answer are believed to be based on improper constructions of the claims, which are detailed below.

a. Group 1: Claims 1 – 4 and 9 – 25

i. Solok1 does not disclose the claim limitations related to access of financial accounts maintained at different financial institutions

Appellant respectfully disagrees with the assertion in the Examiner's Answer that "[t]he question of whether or not the Examiner has factually supported a *prima facie* case of obviousness rises and falls with the weight given to a claim's preamble" (*id.*, p. 8). There are specific limitations recited *in the body of the claims* that "depend[] on the recitation of the preamble for completeness in describing how the invention applies across a plurality of financial institutions" (Appellant Brief, p. 6, n. 2). The issue is thus not merely "whether limitations from a claim's preamble propagate throughout the claim" (Examiner's Answer, p. 8), but rather

whether the recited limitations are disclosed in the cited art as required in establishing a *prima facie* case under §103(a). MPEP 2143.

For example, Claim 1 reads:

1. A system for providing financial services over a public network accessible by a plurality of customers via respective network access devices with modems and over a private network accessible by a plurality of financial institutions via computers with modems, said financial institutions maintaining respective financial accounts for said plurality of customers, at least some of said financial accounts being maintained at different ones of said financial institutions, said system comprising:

for each customer, a network access device including a programmable controller for executing code and a memory for storing a browser software to interface with said public network, said each customer using said network access device and a computer-readable portable storage medium to access said each customer's financial account via said public network, said computer-readable portable storage medium having encrypted and unencrypted information recorded thereon pertaining to said each customer's financial account; and

a decryption processor, connected to said network access device via said public network, for decrypting said encrypted information retrieved from said storage medium such that the financial institution maintaining said each customer's financial account, connected to said decryption processor via said private network, determines an access to said each customer's financial account on the basis of the decrypted information.

(Emphasis added)

The *body* of the claim requires that certain elements be provided “for each customer”, and that those elements enable “access to each customer's financial account” at “the financial institution maintaining said each customer's financial account.” The preamble of the claim merely sets forth a description of an arrangement with which the claimed system interacts, in which “said financial institutions maintain[] respective accounts for [a] plurality of customers” and in which “at least some of said financial accounts be[] maintained at different ones of said financial institutions.” The Examiner's Answer correctly notes that the requirement that some accounts be maintained at different financial institutions does not preclude other accounts from being maintained at a common financial institution (Examiner's Answer, p. 9). But, from this, the Examiner's Answer incorrectly concludes that “[h]ence, the claim is broad enough to read on accounts that are not maintained at different financial institutions” (*id.*, p. 9).

This construction of the claim is untenable. The body of the claim specifically requires that particular elements be provided “for each customer,” and the preamble clearly identifies the financial accounts for some of those customers as being maintained at different

financial institutions. To suggest that the recited elements may be provided only for those customers who maintain accounts at a common institution is inconsistent with the claim requirements that they be provided for each customer for whom the respective financial accounts are maintained. The assertion in the Examiner's Answer that "the body of the claim does not refer back specifically to those accounts that are maintained at different ones of said financial institutions" is thus incorrect.

The Examiner's Answer appears to take the alternative position that even if the claims are construed to require that the claimed invention is applicable across a plurality of financial institutions, "this feature is taught by Solokl" (*id.*, p. 9). As Appellant best understands, the basis for this assertion is that Solokl teaches that the system may accommodate purchases supported by a credit card in addition to those purchases that rely on access to the customer's financial account maintained at the service partner bank (denoted 18 in Solokl). Specifically, the Examiner's Answer cites the following:

Alternatively, the service may provide credit card information to the merchant, e.g. a VISA or MasterCard, which is then settled within the credit card company's system. In such an embodiment of the invention, it may be necessary under current practices for the merchant to have a contractual relationship with the service. One advantage of this embodiment of the invention is that credit cards are universally accepted and the protection can be applied prior to providing the purchase authorization code to the merchant for the transaction. Accordingly, the service may be used universally.

(Solokl, Col. 6, ll. 40 – 50, reference numbers omitted, emphasis added).

The cited portion merely notes that the system may provide a mechanism for executing credit-card transactions as an adjunct to the principal focus of Solokl on providing access to a financial account maintained at the service partner bank. Such credit-card transactions are described as conventional credit-card transactions that are "settled within the credit card company's system" (*id.*, Col. 6, ll. 42 – 43). Nothing in Solokl teaches or suggests using such a credit-card system to "determine[] an access to said each customer's financial account on the basis of the decrypted information," as the claims require; the only accounts for which access is arguably determined in Solokl are all maintained at the service partner bank ("Before a teen ... can enter into a transaction with a merchant using the invention, it is first *necessary* that an account be

established with the service,” *id.*, Col. 4, ll. 12 – 15, emphasis added; *see also id.*, Col. 5, ll. 47 – 49).

The statements in the Examiner’s Answer that “it would have been obvious ... that different users can have accounts in different banks” and that “individual or different users would have different or multiple credit cards” (Examiner’s Answer, p. 10) may or may not be true when taken in isolation. But, in context, Solokl does not describe a system that would allow access to financial accounts maintained in different financial institutions; the system described in Solokl only permits access to financial accounts maintained at the single service partner bank.

ii. There is no motivation to combine Solokl with Newton in the manner claimed

It is respectfully believed that the clarification provided in the Examiner’s Answer of how Solokl is proposed to be combined with Newton is inconsistent with what is claimed. In particular, the Examiner’s Answer draws a distinction between initially logging into the system and providing the information needed to execute a transaction:

[T]he Examiner specifically points out that users of the Solokl et al. system are required to login into an account in order to initiate a transaction. Note, this step is prior to and distinct from the transmission of a pass phrase.

(Examiner’s Answer, p. 11, citations omitted, emphasis added).

The Examiner’s Answer proposes to use the technique disclosed in Newton of providing ultra-long user identification codes as a mechanism for initially logging into the system (*id.*, p. 11), *not* as a mechanism for determining access to a financial account; it is the transmission of the pass phrase in Solokl that is used to determine access to a financial account (“The pass phrase is used to lookup a four digit PIN number in the service database which is then sent to the bank via the ATM system,” Solokl, Col. 7, ll. 55 – 57). But the claims require that access to each customer’s financial account be determined “on the basis of the decrypted information” that originates from the computer-readable storage medium.

Thus, while Appellant has no particular quarrel with the view (which is now more fully understood) that the technique of Newton might be used *to log on* to the system of Solokl, such a view is believed to be irrelevant to the claims. The limitations recited in the claims make

clear that the information extracted from the computer-readable storage medium is used in determining access to a financial account, not merely to providing a mechanism for logging onto a system. Even the Examiner's Answer emphasizes that these functions are "distinct" within the context of Solokl's disclosure.

b. Group 2: Claims 5 – 8

In responding to Appellant's argument that Bocinsky fails to disclose the limitations of Claims 5 – 8 requiring extraction of a second identifier and re-encryption of the extracted second identifier, the Examiner's Answer cites portions of the specification to conclude that "[C]laim 5, in light of the Appellant's disclosure[,] teaches the first identifier ... coinciding with the second identifier" (Examiner's Answer, p. 13). The argument provided in the Examiner's Answer consequently relies entirely on this coincidence of the first and second identifiers in arguing disclosure of the limitations of Claim 5 in Bocinsky.

But such a conclusion is inconsistent with the limitations specifically recited in the claims. In particular, the "first identifier" is defined in Claim 3 as entered by the customer in response to providing part of the unencrypted information from the computer-readable storage medium ("... such that at least part of said unencrypted information is provided to said customer who is requested to enter a first identifier related to said customer's financial account," Claim 3, emphasis added). In contrast, the "second identifier" is extracted from the information originally provided on the computer-readable storage medium and decrypted by the decryption processor ("... wherein said decryption processor is operative to extract a second identifier pertaining to said customer's financial account from the decrypted information and to re-encrypt the extracted second identifier," Claim 5, emphasis added). A single identifier cannot both be provided by the customer and extracted from information originally in encrypted form on the computer-readable storage medium, so that the recited first and second identifiers must clearly be distinct. Accordingly, the fundamental basis on which the Examiner's Answer relies, namely that "the claims are absent language that specifically distinguishes a first identifier from being distinct from a second identifier" (Examiner's Answer, p. 14) is incorrect.

3. Conclusion

For the above reasons, Appellants continue to believe that all pending claims are patentable.

Respectfully submitted,

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ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
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